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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,001	08/01/2003	Walter Harvey Waddell	2003B079	8961

23455 7590 08/28/2007
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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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08/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,001

Applicant(s)

WADDELL ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-14, 16-25, 27-31, 33-35, 38-43, 47-49, 51 and 53-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-14, 16-25, 27-31, 33-35, 38-43, 47-49, 51 and 53-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/2007 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 112

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 12, the term "the copolymer" lacks antecedent basis.

Claim Rejections - 35 USC § 103

4. Claims 1-4, 6-14, 16-25, 27-31, 33-35, 38-43, 47-49, 51, and 53-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al (WO 02/48257 A2, cited on IDS dated 12/15/2003).

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With respect to claims 1-4, 6-14, 16-25, 27-31, 33-35, 38-43, 47-49, 51, and 53-83, the rejection is adequately set forth in paragraph 5 of Office mailed 3/29/2006 and is incorporated here by reference.

With respect to new claims 84-87, the rejection for the claims above covers the material in these new claims.

Response to Arguments

5. Applicant's arguments filed 8/17/2007 have been fully considered but they are not persuasive. Specifically, applicant argues that applicant's data is reasonably commensurate in scope with the scope of the claims.

In response, the examiner has considered the 3 types of carbon black used in the inventive data in the specification as originally filed and maintains that these carbon blacks are not commensurate in scope with the claimed carbon black which has $\text{DBP} < 80 \text{ cm}^3/100 \text{ g}$. In particular, Regal 90 ($\text{DBP} = 33 \text{ cm}^3/100 \text{ g}$), Regal 90 ($\text{DBP} = 32 \text{ cm}^3/100 \text{ g}$), and N-990 ($\text{DBP} = 42 \text{ cm}^3/100 \text{ g}$) are exemplified, wherein DBP of 32, 33, and $42 \text{ cm}^3/100 \text{ g}$ cannot be used to establish criticality for less than $80 \text{ cm}^3/100 \text{ g}$ when compared to N660 ($\text{DBP} 90 \text{ cm}^3/100 \text{ g}$). The contention that "the exact limit [of DBP] is somewhere between 42 and 90" (page 17) does not alter the examiner's position. Furthermore, the argument that there are not hundreds of commercially available carbon blacks which read on the genus of presently claimed carbon blacks does not persuade the examiner given that the commercial availability of specific carbon blacks does not affect patentability and further given that the scope of the genus is still much too broad to be supported by the exemplified carbon blacks.

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Additionally, the exemplified amounts of carbon black are only as high as 120 phr.

Given that the amount of carbon black significantly affects the properties as shown by Tables 5 and 6, applicant cannot establish a statistically commensurate scope of up to 200 phr carbon black (note that this amount of carbon black is not the total amount of all carbon black, rather, it is the amount of carbon black having surface area $< 30 \text{ m}^2/\text{g}$ and DBP $< 80 \text{ cm}^3/100\text{g}$).

Finally, only bromobutyl elastomers are exemplified and cannot establish criticality for presently claimed generic elastomer comprising at least 30 mol % isobutylene.

Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/22/2007
Vickey Ronesi



/Vasu Jagannathan/
Supervisory Patent Examiner
Technology Center 1700